

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)	Confirmation No.:	1016
SMITH et al.)		
)	Group Art Unit.:	2863
Serial No.:)		
09/746,754)	Examiner:	Bhat, A.
Filed:)		
21 December 2000)	Customer No.:	006980
Title:)		
INITIAL CALIBRATION OF A)	Attorney Docket No.:	POLY8
LOCATION SENSING)		
WHITEBOARD TO A)		
PROJECTED DISPLAY)		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Honorar Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Atlanta, GA 30308
17 March 2006

Sir:

Applicant respectfully requests review of the *Final Office Action* issued in the above-referenced application. No amendments are being filed with this *Request*. This *Request* is being filed together with a *Notice of Appeal* pursuant to 37 C.F.R. § 1.91(a). Additionally, a *Request for an Extension of Time* of one month, and the accompanying fee are being filed with this *Request*. The review is requested for the reasons set forth below.

1. Overview

By the *Final Office Action* of 17 November 2005, the Examiner rejects Claims 41-42 and 44-53. By the present *Request*, Claims 41-42 and 44-53 remain pending.

Claims 41-42 and 44-53 are rejected under 35 U.S.C. § 102(b), as being anticipated by the May 1998 SMART Board Product Manual (“*Manual*”).

2. Claims - Admissions as Prior Art

Claims 41, 46, and 50 are independent claims drafted in *Jepson* format. MPEP § 2129, 608.01(m); and 37 C.F.R. § 1.75(e). Claims presented in *Jepson* format are taken as an admission that the subject matter of the preamble is prior art work of another. 37 C.F.R. § 1.75(e). Accordingly, the claimed portion up to the transition “the improvement comprising” is considered prior art, and those elements, steps, and/or relationships that follow the transition constitute that portion of the claimed combination which the Applicant considers as the new or

improved portion. *Id.* Thus, this *Request* focuses on the portion of the Claims that include the new or improved portions.

3. Summary

The Examiner correctly states that the meaning of the examined Claims must be interpreted as broadly as their terms reasonably allow. The Examiner further correctly states that the words of the Claim must be given their plain meaning unless Applicant provides a clear definition in the *Specification* (sometimes “*Spec.*”). *11/17/05 Office Action*, Pg. 5.

The *Specification* discloses steps in the calibration process of an electronic whiteboard. The whiteboard is connected to a computer, which is coupled to a projector for projecting an image onto the whiteboard. Proper calibration enables positions on the whiteboard to relate to locations on the computer, and vice versa.

While the *Specification* discloses steps of calibration, the Claims relate specifically to only ***the initiation*** of the process. That is, Applicant does not claim that ***any step*** of calibration is performed distant the computer. Applicant acknowledges that some of the steps of calibration occur distant a computer, as taught by the cited reference and as confirmed in the *Specification*. For instance, the step of touching calibration points at the whiteboard is “performed distant the computer.” The claimed invention, however, recites that the step of ***initiation of calibration***, *i.e.*, that particular step before projecting a calibration image onto the whiteboard, occurs distant a computer. This is a novel and non-obvious recitation over the cited reference.

The Examiner may not interpret a term of a Claim by a cited reference when the Applicant defines the term in the *Spec.* (“extrinsic evidence cannot alter any [C]laim meaning discernible from intrinsic evidence” *C.R. Bard, Inc. v. United States Surgical Corp.*, 388 F.3d 858, 862 (Fed. Cir. 2004)) The Examiner, however, does exactly this by rejecting the claimed invention as alleged in the *Office Action*, by defining terms of the claimed invention by the *Manual*.

4. Arguments

A. Defining the Calibration Process

Calibration, as defined in the *Specification*, enables “[a] computer [to] relate positions on [a] whiteboard to locations on [a] computer display device, and thus, properly interpret touch inputs detected on the surface of the electronic whiteboard.” *Spec.*, Pg. 2, L. 9-12.

The conventional calibration process includes at least three steps. First, a calibration image is projected onto a whiteboard. Second, the system detects the touch(es) of the user on the

whiteboard, wherein the user has approached the whiteboard, and touched where instructed from the first step of the calibration process. Third, the system calculates a relationship between the touched point(s) on the whiteboard corresponding to the projected calibration image and the position(s) of the display device. *Spec.*, Pg.5, L. 11-24, Fig. 3; 09/07/05 *Response and Amendment*, Pgs. 4-5.

Applicant's currently claimed invention, however, concerns the *initiation* of the calibration sequence. See *Spec.*, Pg. 6, L. 9-19. Prior art systems must initiate the calibration process at the computer. That is, the action immediately prior to the calibration image being projected on the whiteboard occurs at the computer. This is exemplified in the *Manual*. The present Claims, however, recite that this action occurs distant the computer.

B. Defining the Step of Initiation

The step of initiation is clearly defined in the *Specification*, and thus the Examiner must give weight to this clear definition, and not allow the cited reference to somehow redefine this term. The step of initiation is defined as the step before displaying a GUI (graphical user interface) onto the electronic whiteboard. *Spec.*, Pg. 2, L. 29-30. Indeed, the initiation "signals the computer to begin the calibration procedure before the computer has projected a GUI [] onto the electronic whiteboard surface." *Id.* This step of initiating calibration takes place distant the computer. *Spec.*, Pg. 6, L. 12-19. Accordingly, the step of initiation, in one example, is the step before projecting a GUI onto the electronic whiteboard taking place distant a computer. Thus, the next step is projecting the GUI onto the electronic whiteboard.

C. 1998 SMART Board Product Manual

Claims 41-42 and 44-53 are rejected under 35 U.S.C. § 102(b), as being anticipated by the *Manual*. The Examiner rejects all new or improved portions of all the Claims based on two pages of the *Manual*, i.e., pages 27-28.

The *Manual* identifies five required steps to "orient" the SMART board. Step 1 includes: "Select Orient Board from the Board menu, or Press the Orient Board button ..., or click or press twice on the SMART Board icon in the System Tray, or Press the Pen Tray buttons simultaneously." Step 2 includes: "Preview the three orientation levels ... by clicking on the circle next to each heading." Step 3 includes: "Once you have determined the orientation level you prefer, select it by clicking the appropriate circle." Step 4 includes: "Click the Next button." Step 5 includes: "Follow the on-screen instructions, pressing your finger squarely on the yellow center of each red cross, in the order specified by the large white arrow. To begin the

orientation, press on the cross highlighted in red at the upper-left corner of the screen. You will hear a beep and the next cross in the series will be highlighted in red.” *Manual Pgs. 27-28*.

The Examiner states that the title of the section on page 27 of the *Manual* is “to orient the SMART board,” and therefore deduces “this section [of the *Manual*] is specifically directed to orienting the smart board and more th[a]n merely turning on power and cannot be interpreted [by the Examiner] as such.” *11/17/05 Office Action, Pg. 6*. Moreover, the Examiner continues, “[s]ince the orientation/calibration process is broken down into five steps the first step is interpreted as the beginning of that process. It should also be noted that the subsequent steps (2-5) require the previous step (1) therefore it is within reasonable interpretation to conclude that the calibration process begins at step one.” (emphasis added) *Id.* The Examiner, however, ignores the Applicant’s defined meaning of initiating orientation/calibration is the step before projecting a GUI onto the electronic whiteboard distant the computer, not a step after.

D. The 1998 SMART Board Product Manual Does Not Anticipate the Pending Claims and the Rejection Should Be Withdrawn

The currently claimed invention teaches an improved process of initiating calibration, e.g., calibration is initiated distant a computer. *Spec., Pg. 6, L. 9-19*. Indeed, once a user initiates calibration distant the computer, a dialog box appears on the surface of the electronic whiteboard, instructing the user to touch the surface of the electronic whiteboard at one or more calibration points. *Id. at 6, L. 21-29*. Once the user has touched the calibration points, then the computer uses the locations where the touch was detected to relate each location to a certain position on the computer display corresponding to that location. This completes the calibration process. *Id. at 6, L. 29-31*. Accordingly, all the steps of the calibration process for the present invention, including the initiating step are performed distant the computer.

The Examiner alleges that the *Manual* teaches that the calibration is initiated distant the computer in Step 1. The initiation of calibration, as defined by Applicant, is a step that is before the projection of a GUI onto an electronic whiteboard surface occurring distant a computer. This is unambiguously Step 4 as disclosed in the *Manual*, and this Step 4 occurs at the computer, as distinguished by the claimed invention.

In addition, completing Step 1 as taught in the *Manual* means that a user still has three more steps (Steps 2-4) to complete – **at the computer** – before a calibration image (i.e., GUI) is projected onto the SMART board. These are the precise steps the claimed invention removes, thus providing an improved system (see *Spec. Pg. 2, L. 12-18, 25-27* and *Pg. 3, L. 13-17*). The

claimed invention removes the need of a user to revisit the computer to initiate, and also complete, calibration. Indeed, steps 2 through 4 require “clicking” of a mouse at the computer. *Manual* Pgs.27-28, and 09/07/05 *Response and Amendment*, Pg. 8. The *Manual* further requires that the calibration process is initiated only after *clicking* – hence, at the computer – the “Next button”. Thus, only after Step 4 has the calibration been initiated, but not before. *Id.*

Accordingly, Claim 41, and dependent Claims therefrom, are not anticipated by the *Manual*. Claim 41 recites that the initiation of the calibration process occurs distant the computer. *See Spec., Fig.3*. The *Manual* teaches initiating calibration at the computer, *i.e.*, Step 4. *Manual* Pgs. 27-28.

Additionally, Claim 46, and dependent Claims therefrom, are also not anticipated by the *Manual*. Claim 46 recites that the step of initiating is but a **single step**, and immediately after this step, the step of projecting an image onto the whiteboard takes place. *See Spec., Fig.3*. If, as the Examiner suggests, the *Manual* describes beginning the orientation at Step 1, and projecting at Step 4, *Manual* Pgs. 27-28, at least Claim 46 and its dependents must be patentable, as Steps 1-4 cannot be interpreted as being a “single step” as recited in the Claim.

Moreover, Claim 50, and dependent Claims therefrom, are also not is not anticipated by the *Manual*. Claim 50 recites the improved step of projecting a calibrated image onto the whiteboard directly preceded by the step of signaling the whiteboard system to project the calibration image, the step of signaling the whiteboard system at a location distant a computer. This improvement is not disclosed or taught in the *Manual*. As discussed above, these set of Claims must also be patentable over the *Manual* in view of the Examiner’s allegations of what it teaches.

Moreover, the *Manual* does not teach or disclose the limitation of pressing a button on a remote to initiate calibration, as recited in Claims 45, 49, and 53. *See Spec. Pg. 6, L.9*.

5. Conclusion

For the reasons stated above, it is respectfully requested that all the rejections be withdrawn and that this application be allowed in a timely manner.

Respectfully submitted,
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